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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,858	08/20/2001	Joshua R. Buessler	109909-129577	7444

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EXAMINER

LE, LANA N

ART UNIT PAPER NUMBER

2685

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/933,858

Applicant(s)

BUESSELER ET AL.

Examiner

Lana N Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08/12/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31-41 is/are allowed.
- 6) ☒ Claim(s) 1,2 and 26-29 is/are rejected.
- 7) ☒ Claim(s) 3-25 and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments and declaration with respect to claim rejection under 35 U.S.C 102 and 35 U.S.C 103 have been considered and have been withdrawn.
2. Applicant's arguments filed 1-26-04 regarding the double patenting have been fully considered but they are not persuasive.

Regarding claim 1, applicant's remarks regarding lack of utility in the cited reference, Buessler et al (US D470,135) is not persuasive in that the shown figures 1-7 of Buessler et al (US D470,135) represent the claimed subject matter of applicant's claim 1 which merely depicts the shape of the cover and what its circumference is composed of, i.e. a front, side, and back surface. The intended use of the cover is to cover a mobile phone as cited in claim 1 of the cited reference. The detailed reason for the obviousness double patenting stands rejected as set forth in the previous office action filed 04/04/04.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-2, 26-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. D470,135S. Although the conflicting claims are not identical, they are not patentably distinct from each other because the interchangeable cover to be placed over a mobile phone that is shown and described in figs. 1-7 of claim 1 of prior art reference # US D470,135 S has the same U-shaped feature used to cover a mobile phone's front, side, and back that is described in the present application claim 1, except for a resilient semi-rigid shell which is not described in the claim 1 of US D470,135 S but appears to be a hard shell according to the figure 1 shown and would be obvious to one of ordinary skill in the art in which the material used to cover the phone can be made of any kind of well-known material and its elasticity, i.e. rubber, plastic, metal, etc. which would not be considered an essential or necessary part of the claimed invention to be practiced with this specific detail of well-known material used for it to be considered novel to one of ordinary skill in the art and therefore can be omitted without affecting the claimed invention.

The two-way obviousness double patenting rejection in which claim 1 of the prior art D470,135S claim an ornamental aspect or design can be any type of broad and various

kinds of ornamental design in which the ornament can be a decorative shape as shown in fig. 1 or to ornament with molding of the contour of the interchangeable cover to fit the mobile phone via a U-shaped profile to cover a front, side, and back as shown and described in figs. 1-7 of the prior art reference. Claim 1 of the prior art reference specifically said the cover "as shown and described" in which the figures shown can represent the description of the similar features claimed in words to describe the U-shaped profile in claim 1 of the present application. The "interchangeable cover for a mobile phone" claimed in claim 1 of the prior art reference D470,135 S would be able to function as a cover or in other words a cover is defined as an outer layer/wrapper for protection of an object/device, utilized to overlay or appear here and there on the surface of the object/device. Therefore, when it is assembled over the mobile device as claimed in claim 1 of the present application, the cover claimed in claim 1 of the prior art reference would act or be utilized as an outer layer/wrapper when it is placed/overlayed over the mobile device as in the definition of a cover. In conclusion, the ornamental and utility aspect of claim 1 of the prior art reference reads onto claim 1 of the present application and would not be considered patentably distinct from each other.

Regarding claim 1, Buessler et al discloses an interchangeable cover (fig. 1) for a mobile communications device comprising:

a front face and back face commonly connected to a side portion and having a substantially U-shaped profile adapted to wrap around a substantial portion of a front, back and side of the mobile communications device upon assembly over the mobile communications device (claim 1 as shown and described in figures 1-7). Buessler et

al didn't disclose: the cover comprises a resilient semi-rigid shell. However, the examiner takes official notice that the material used to make the cover of the mobile phone of Buessler can be made of any kind of well-known material, i.e. rubber, plastic, metal, semi-rigid shell, or any other alternative kind. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the cover shown in figs. 1-7 of Buessler et al to have a resilient semi-rigid shell as one of many alternative materials in order to preferably choose a hard cover to better protect the phone from damage and deformation.

Regarding claim 2, Buessler discloses the interchangeable cover of claim 1 for a mobile communications device comprising: wherein the resilient semi-rigid shell is adapted to be secured to the mobile communications device without any fasteners (see fig. 1; claim 1 "interchangeable cover"). It would have been obvious to one of ordinary skill in the art at the time the invention was made to derive from the interchangeable cover of claim 1 that the cover fits over the phone perfectly and securely without the need for any screw or tightener.

Regarding claim 26, Buessler discloses the interchangeable cover of claim 1 for a mobile communications device comprising: that the mobile device comprises a cellular phone (see fig 1, "mobile phone of claim 1").

Regarding claim 27, Buessler discloses the interchangeable cover of claim 1 wherein Buessler didn't specifically disclose the mobile communications device comprises a pocket PC. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the mobile phone of Buessler et

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al with a pocket PC in order to fit any other alternative type of communication device that has the shape of a mobile phone with the interchangeable cover of claim 1 of Buesseler.

Regarding claim 28, Buesseler discloses the interchangeable cover of claim 1 wherein Buesseler didn't specifically disclose the mobile communications device comprises a two-way pager. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the mobile phone of Buesseler et al with a two-way pager in order to fit any other alternative type of communication device that has the shape of a mobile phone with the interchangeable cover of claim 1 of Buesseler.

Regarding claim 29, Buesseler discloses the interchangeable cover of claim 1 wherein Buesseler didn't specifically disclose the mobile communications device comprises a pocket PC. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the mobile phone of Buesseler et al with a pocket PC in order to fit any other alternative type of communication device that has the shape of a mobile phone with the interchangeable cover of claim 1 of Buesseler.

***Allowable Subject Matter***

2. The following is an examiner's statement of reasons for allowance:

3. Claims 3-25, and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. Claims 31-41 are allowable over the cited prior art.

Regarding independent claims 31 and 40, the cited prior art fails to disclose or suggest the claimed invention for the remarks and amendments made in applicant's remarks, paper #5.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lana Le whose telephone number is (703) 308-5836. The examiner can normally be reached on M-F.

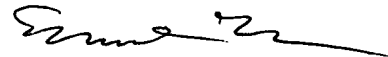
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (703) 305-4385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lana Le

March 13, 2004



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